

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on August 12, 2005, the Examiner rejected claims 29-33 under 35 U.S.C. 101, rejected claims 1-10 and 22-33 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran et al (United States Patent No. 6,457,640, hereinafter “Ramachandran”) in view of Kurijai et al (United States Patent No. 6,618,566, hereinafter “Kurijai”), rejected claims 11-13 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kurijai and further in view of the specification, and rejected claims 14-21 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kurijai and further in view of Shaw et al (United States Patent No. 5,602,974, hereinafter “Shaw”). Accordingly, Applicant respectfully provides the following:

Rejection under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 29-33 under 35 U.S.C. 101. Applicant respectfully submits that the amendments provided herein overcome the rejections made under 35 U.S.C. 101.

Rejections under 35 U.S.C. 103

In the Office Action, the Examiner rejected claims 1-10 and 22-33 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kurijai, rejected claims 11-13 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kurijai and further in view of the specification, and rejected claims 14-21 under 35 U.S.C. 103(a) as being unpatentable over Ramachandran in view of Kurijai and further in view of Shaw. Applicant respectfully submits that the claim set provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, independent claims 1, 22 and 29 recite limitations relating to receiving a request to render a print job; determining a cost for consumables that would be used in rendering the particular print job prior to despooling print data of the print job to the printing device; determining an amount of available funds in a user's account; and if the amount of available funds exceeds the cost for consumables, charging the cost to the account and rendering the print job at the printing device. The limitations are supported by the disclosure as originally filed. For example, reference is made to pages 5, 10, and 16-30 of the original disclosure. And, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations.

Instead, Ramachandran teaches an ATM that is operatively programmed to accept a fee from a user in exchange for outputting either digital information or saving digital information to a portable storage medium or portable computing device. (see col 4, lines 50 – 53) The fee of Ramachandran is a standard fee for any output of the ATM. In contrast, the present invention claims determining a cost for consumables that would be used in rendering the particular print job. The determined cost is specific to the particular print job as opposed to a standard fee for all outputs.

Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations of independent claims 1, 22 and 29. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious independent claims 1, 22 and 29 as provided herein.

In addition, dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited references do not teach or suggest, alone or in combination, the limitations claimed in the present claim set and therefore do not make obvious the claim set provided herein.

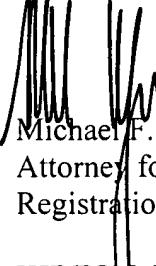
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 10 day of November, 2005.

Respectfully submitted,


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